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In the
Supreme Court of the United States

October Term, 1969

B & L SALES ASSOCIATES,
Petitioner

v.

H. DAROFF & SONS, INC.,
Respondent

Respondent's Brief In Opposition To Petition For Writ of Certiorari

The Respondent, H. Daroff & Sons, Inc., respectfully submits that the Opinion of the Court of Appeals was proper and correct, and that no Writ of Certiorari should issue.

This is a conventional trade case wherein Petitioner complained mainly about Respondent's advertising.

A review of the Petition for Certiorari shows that Petitioner does not question the constitutionality or interpretation of any part of the trademark laws, but rather, disagrees that the case should be disposed of on Summary Judgment. As such, a Petition for Certiorari merely expresses Petitioner's private complaint, and fails to

assert anything of a public moment that would make this case a matter of national interest.

As explained hereinafter, the grant of Summary Judgment is strictly in accord with the 1963 Amendment to Rule 56(e) of the Federal Rules of Civil Procedure.

1. The phrase "come on strong" is descriptive and in the public domain.

The Court of Appeals stated (A. 18):[1]

> " 'Come on Strong' and variations of that phrase, as the various exhibits amply demonstrate, is a common slang term, the general use of which plaintiff cannot prevent by registering it in connection with certain goods."

The Record of the Court below established beyond all doubt that the term "Come on Strong" is the title of a Broadway play, is the title of numerous songs, is found in certain slang dictionaries, and spontaneously appears even to the present time in commercial and non-commercial literature, broadcasting and everyday parlance.

2. Petitioner did not originate the phrase "come on strong".

Petitioner did not originate the slogan, but instead, has simply attempted to establish a trademark monopoly in it, something which the Court of Appeals forbade.

The foregoing quote from the Court of Appeals' Opinion (A. 18) shows that Petitioner has no basis to complain when Respondent uses the term "Come on Strong" in the precise way that it existed when Petitioner attempted to claim this slogan as its trademark.

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1. "A" refers to the Appendix attached to Petitioner's Brief.

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3. Respondent has used the phrase "come on strong" only in the descriptive meaning and always in connection with its renowned trademarks.

Furthermore, Respondent always applied its renowned names "Botany 500" or "Daroff" prominently in any advertisement which used the phrase "Come on Strong" in a descriptive sense only. As the Court of Appeals stated (A. 16):

> "It is quite obvious that the phrase 'Come on Strong' was intended only to describe the manner in which Botany 500 clothing would assist the purchaser in projecting a commanding, confident, 'strong' image to his friends and admirers, and no intent to use the phrase in a trademark sense can be inferred from these promotional materials. Moreover, the statement by Affidavit of Daroff's vice president that defendant has never directly applied the phrase to its products by tag, label or otherwise is unchallenged."

In view of all of the foregoing it is clear that the case of *Menendez v. Holt*, 128 U.S. 514 (1888)—cited on page 7 of Petitioner's Brief—has no application to the facts at bar since the Courts below found that Respondent in the case at bar simply has not used the slogan "Come on Strong" as a trademark.

4. There is no conflict among decisions of the courts of appeals.

The only case cited as conflicting by Petitioner, on page 8 of its Brief, is *Albert Dickinson Co. v. Mellos Peanut Co.*, 179 F.2d 265 (7th Cir. 1950). However, the decisive point in the *Albert Dickinson* case was that Summary Judgment could not be entered as a matter of law because the District Court had employed the improper test of a side-by-side visual comparison of the trademarks in issue.

The case at bar involves an entirely different point, namely, the association of the descriptive phrase "Come on Strong" with Respondent's nationally known trademarks "BOTANY 500" and "DAROFF".

Furthermore, the *Albert Dickinson* case was decided long before the Amendments to Rule 56(e) of the Federal Rules of Civil Procedure, which now require a positive showing by the non-moving party on penalty of having Summary Judgment granted against him as will be discussed in Section 5 hereof.

5. Petitioner failed to satisfy the burden imposed by Rule 56(e) of the Federal Rules of Civil Procedure.

Rule 56(e) was amended in 1963 to include the following last sentence:

> "When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of his pleadings, *but his response by affidavits or as otherwise provided for in this rule, must set forth specific facts showing that there is a genuine issue for trial.* If he does not respond, summary judgment, if appropriate, shall be entered against him." (Emphasis Added)

In the case at bar Respondent filed a properly supported Motion for Summary Judgment.

At this point, Rule 56(e) applies to shift the burden to Petitioner to establish a *genuine* issue of fact, and indeed, Petitioner's Affidavits show numerous attempts to do so.

However, the Court of Appeals recognized that Petitioner's Affidavits could not overcome the major premise upon which Respondent's Motion for Summary Judgment was based. As the Court of Appeals stated (A. 17):

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"It may be that some of the factors listed above were disputed in the pleadings and affidavits, but the trial court correctly concluded that those factors were not sufficient to overcome the obvious inference from the exhibits themselves that no consumer or professional buyer of men's suits could possibly mistake the source of the advertised goods by believing that they were manufactured by plaintiff. That fact alone, weighed against all of plaintiff's allegations, affidavits and arguments eliminated even the possibility of confusion and entitled Daroff to summary judgment."

Furthermore, the Court of Appeals held (A. 17, A. 18) that Respondent was entitled to Summary Judgment on a second ground, namely, a statutory defense of descriptiveness under 15 U.S.C. 1115(b). This second defense clearly transcends Petitioner's arguments which are directed only to the first defense upheld by the Court of Appeals.

6. The courts below have not weighed a number of fact issues.

The portion quoted from the Court of Appeals' Opinion in Section 5 above shows that the Court of Appeals expressly refused to weigh a number of fact issues since it held that the various factors contended for by Petitioner "were not sufficient to overcome the obvious inference from the exhibits themselves . . .".

Furthermore, this Court has expressly ruled that Rule 56(e) cannot be read out of anti-trust cases. See *First National Bank of Arizona v. Cities Service Co.*, 391 U.S. 253, 289, 290 (1968), and so there is no reason for reading Rule 56(e) out of the far simpler trade cases, such as the present one which raises conventional issues.

7. Petitioner was fully informed as to the grounds for summary judgment that were relied upon by the courts below.

Both the Court of Appeals and the District Court were in complete agreement that Summary Judgment should be entered in favor of Respondent because Respondent's advertising materials did not constitute an infringement upon Petitioner's rights.

Petitioner is in error on page 12 of its own Brief when it states that Respondent's Motion papers were, directed solely to the issue of invalidity of the mark. Indeed, Appendix C and Appendix D attached to Petitioner's Brief do not support Petitioner's thesis that Respondent's Motion was directed to the issue of invalidity.

In reviewing Appendix C and Appendix D to Petitioner's Brief it will be seen that the word "invalid" does not appear even once in the two Appendices. Instead, the essence of the Appendices is that Petitioner had a weak, *descriptive* mark and was incapable, as a matter of law, of showing a *secondary meaning*. This is the trademark way of saying there is no infringement, and has nothing to do with validity.

8. Petitioner was afforded due process.

In view of the fact that the Courts below correctly applied Rule 56(e), it is clear that Petitioner was fully accorded due process. Thus, the Courts below correctly relieved Respondent of the necessity of having to participate in a trial where Respondent was already entitled to judgment, *as a matter of law*, on two separate and distinct defenses.

While Petitioner briefly makes reference to the denial of its claim to jury trial on pages 3 and 4 of its Brief, Petitioner has failed to specify any constitutional provision,

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statute or grounds for application of any decision of this Court that would sustain the necessity to review any alleged right to trial by jury.

CONCLUSION

There is nothing in the case at bar of a public moment or national interest.

The case involves the simple application of the infringement section of the trademark law (15 U.S.C. 1114[1]) and the defense of descriptiveness (15 U.S.C. 1115[b]). There is no issue as to the constitutionality or interpretation of any portion of the trademark law.

Respondent made a strong showing before the District Court that judgment should be entered in its favor as a matter of law. The Court of Appeals affirmed the District Court. At no time did anything of a public moment or national interest ever appear that would require a review by this Court.

Therefore, the Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

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